

Remarks

Reconsideration of this Application is respectfully requested.

Based upon the above Amendments and the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Upon entry of the forgoing amendment, claims 1-4 and 15-36 and 38 are pending in the application, with claims 1, 24, 29, 31, 33, 34, 35 and 38 being the independent claims. Claims 1, 24, 29, 31, 33, 34, 35 and 38 are sought to be amended. Claims 6-8, 10-11, 13-14 and 37 are sought to be canceled without prejudice or disclaimer, and Applicants reserve the right to prosecute these claims in a divisional application. Claims 5, 9 and 12 were previously canceled without prejudice or disclaimer, and Applicants again reserve the right to prosecute these claims in a divisional application. Claim 38 has been withdrawn from consideration, but rejoinder to the remaining claims is respectfully requested upon allowance. These changes are believed to introduce no new matter, and their entry is respectfully requested. Support for the amendments is found throughout the application and the originally filed claims.

Applicants further note that the claims have been limited to compounds wherein $m+n=4$, in accordance with the Restriction Requirement as set forth in previous Office Actions.

Applicants again wish to thank the Examiner for pointing out the allowability of Claim 15.

Rejections Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 1-4, 6-7, 10, 13 and 16-37 under 35 U.S.C. § 112, first paragraph, as lacking enablement for the unlimited scope of all heterocyclic rings encompassed by the claims.

Applicants respectfully disagree with the Examiner's assessment. First, Applicants did indeed respond to the corresponding rejection in the non-final Office Action by canceling the subject matter wherein U and V are independent from the claims, leaving only compounds wherein U-V form a ring. The original rejection stated that the

subject matter wherein U-V formed a ring was enabled. Subject matter where U-V formed structures other than a ring was canceled without prejudice or disclaimer, in order to expedite prosecution. Applicants reserved the right to prosecute the compounds wherein U and V are independent in a divisional application, and continue to reserve said right.

Here, the Examiner expanded the enablement rejection to include certain compounds where U and V formed a ring structure, but noted that description and starting material could be found for the scope of claims 8, 11 and 14. Again, Applicants have canceled the subject matter not covered by these claims without prejudice and disclaimer, and again reserve the right to prosecute the compounds where U and V form ring structures other than those presently claimed.

By introducing the claim limitations of claims 8, 11 and 14 (which the Examiner stated were disclosed in terms of both description and starting material), Applicants believe that they have overcome the Examiner's rejection.

Therefore, this rejection is rendered moot, and Applicants respectfully request that the Examiner withdraw the rejection.

The Examiner rejected claims 1-4, 6-8, 10-11, 13-14, 16-28 and 37 under 35 U.S.C. § 112, first paragraph, as lacking support as to enable one skilled in the art to which it pertains as to how to use the compounds. Applicants respectfully traverse this rejection.

There is a relationship between the binding of the claimed compounds to the NMDA receptors and their pharmaceutical properties. The main usefulness of the claimed compounds is the relief of pain. Experiments have been performed to show the pain relieving effect of the claimed compounds, the data for which was presented in Applicants' previous response.

In this instance, the Examiner stated that "[i]f the recitation is explaining that the in vitro and in vivo data in the specification support the scope that the compounds are operable in treating pain, then, no claims to such scope was offered." (*See* the Office Action at 3). Here, Applicants have amended the claims to read that the compounds of the invention are administered in order to alleviate pain, and to list the diseases, disorders

and conditions which can cause pain that can be alleviated by such administration. Claim 38 as amended, although presently withdrawn from consideration, is believed to be allowable, and should be rejoined with the presently pending claims upon allowance.

Applicants have shown a predictable correlation between *in vitro* activity and the *in vivo* analgesic effect of the claimed compounds. A representative number of the claimed compounds show this analgesic effect, thereby enabling one of skill in the art to have a reasonable expectation of success in relieving pain using the claimed compounds, without undue experimentation.

Applicants believe that the rejection has been overcome, and respectfully request withdrawal of this rejection.

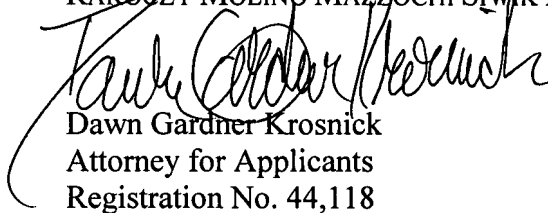
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.

Applicants believe that a full and complete Reply has been made to the outstanding Office Action and, as such, the present Application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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